

Application No.: 09/972124

Case No.: 56764US002

REMARKS

Claims 1-21 are pending. Claims 19 and 20 have been withdrawn from consideration. Claims 1, 7, 8, 9, 14, 15, and 21 are amended.

§ 112 Rejections

Claims 1-18 and 21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Applicants have amended claims 1 and 21 to more clearly define the present invention. These amendments are not intended to, and do not limit the original scope of the claims. Support for these amendments can be found, for example, in Figure 1.

Applicants have additionally amended claims 7 and 8 to more clearly define the present invention. These amendments are not intended to, and do not limit the original scope of the claims. Support for these amendments can be found, for example, in Figure 2.

Claims 9, 14 and 15 have been amended per the Examiner's request. These amendments are not intended to, and do not limit the original scope of the claims.

In summary, Applicants submit that the amendments clarify the Examiner's rejections with respect to the various layered relationships that exist. The Examiner's specific example regarding the adhesive layer does not need further clarification. As is shown in Figure 1, the adhesive layer may be on the third later. However, in Figure 2, an adhesive layer is additionally present on the second major surface of the first layer. The rejection of claims 1-18 and 21 under 35 U.S.C. § 112, second paragraph, has been overcome, and that the rejection should be withdrawn.

§ 102 Rejections

Claims 1-6, 9, 11-13, 16, 18 and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Unexamined Patent Publication H10-90244 ("90244").

The present claims 1 and 21 have been amended to clarify the scope of the invention for the Examiner. The 90244 reference fails to teach a first layer comprising a transparent film, the first layer having a first major surface and a second major surface opposite the first major surface; a

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second layer comprising a fluid transport substrate, the second layer having a first major surface and a second major surface opposite the first major surface, the first major surface of the second layer being in contact with the second major surface of the first layer; and a third layer comprising a fluid transportable ink, the third layer being in contact with the second major surface of the second layer. In the 90244 reference, the ink layer lies between the transparent film and the fluid transport substrate.

The rejection of claims 1-6, 9, 11-13, 16, 18 and 21 under 35 U.S.C. § 102(b) as being anticipated by Japanese Unexamined Patent Publication H10-90244 has been overcome and should be withdrawn.

Claims 1-6, 9, 11, 13, 14, 18 and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent H8-254953 ("254953"). Similarly, the 254953 reference teaches an ink layer that lies between the transparent film and the fluid transport substrate. As stated above, this is contrary to the present claims.

The rejection of claims 1-6, 9, 11, 13, 14, 18 and 21 under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent H8-254953 has been overcome and should be withdrawn.

§ 103 Rejections

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. (See M.P.E.P. 706.02(j).)

Claims 7, 8, 10, 14, 15 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP Unexamined Publication H10-90244 and for claims 7 and 8 in further view of EP 1001264A1 ("EP-264"). Additionally, Claims 7, 8, 10, 12 and 15-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent H8-254953 ("254953") or for

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claims 7 and 8 in further view of EP -264. However, as stated above, neither Japanese reference teaches all the elements of claims 1 or 21. Claims 7, 8, 10, 12, 14, 15, 16 and 17 all depend, directly or indirectly, from claim 1. Therefore, a *prima facie* case of obviousness has not been made with respect to Claims 7, 8, 10, 12, 14, 15, 16 and 17. The rejection of claims 7, 8, 10, 14, 15 and 17 under 35 U.S.C. § 103(a) as being unpatentable over JP Unexamined Publication 110-90244 and for claims 7 and 8 in further view of EP 1001264A1 should be withdrawn. Additionally, the rejection of claims 7, 8, 10, 12 and 15-17 under 35 U.S.C. § 103(a) as being unpatentable over JP -953 or for claims 7 and 8 in further view of EP -264 should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

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Date

Respectfully submitted,

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CHB/spg
56764US002 AMEND 1

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Version with markings to show amendments made:

1. (Amended) An adhesive article comprising
a first layer comprising a transparent film, the first layer having a first major surface and a second major surface opposite the first major surface;
a second layer comprising a fluid transport substrate, the second layer having a first major surface and a second major surface opposite the first major surface, the first major surface of the second layer being in contact with the second major surface of the first layer;
a third layer comprising a fluid transportable ink, the third layer being [associated] in contact with the second major surface of the second layer; and
an adhesive layer.
7. (Amended) The adhesive article of claim 1 wherein the first layer defines a hole, and the second layer is thereby [exposing the second layer] exposed to the air.
8. (Amended) The adhesive article of claim 1 wherein the first layer and the second layer define a hole, and the third layer is thereby [exposing the third layer] exposed to the air.
9. (Amended) The adhesive article of claim 1 wherein the adhesive layer is [associated] in contact with the third layer.
14. (Amended) The adhesive article of claim 1 wherein the first layer further comprises an adhesive.
15. (Amended) The adhesive article of claim 1 wherein the first layer further comprises a release coating.
21. (Amended) A label comprising
a first layer comprising a transparent film, the first layer having a first major surface and a second major surface opposite the first major surface;

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a second layer comprising a fluid transport substrate, the second layer having a first major surface and a second major surface opposite the first major surface, the first major surface of the second layer being in contact with the second major surface of the first layer;

a third layer comprising a fluid transportable ink, the third layer being [associated] in contact with the second major surface of the second layer;

an adhesive layer; and

a printed layer on the first major surface of the first layer.